



Doc Codes: AP PRE-APPEAL

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

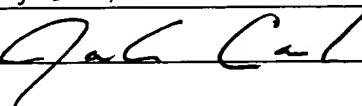
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

119236.00013

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on January 15, 2006

Signature 

Typed or printed name Jack M. Cook

Application Number

09/978,524

Filed

October 16, 2001

First Named Inventor

Gary H. Knauf

Art Unit

1762

Examiner

Tsoy, Elena

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

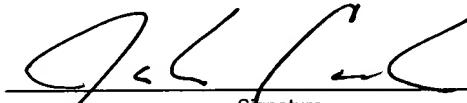
This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- applicant/inventor.
- assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- attorney or agent of record. 56,098
Registration number _____
- attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

Jack M. Cook

Typed or printed name

(414) 577-5405

Telephone number

January 25, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

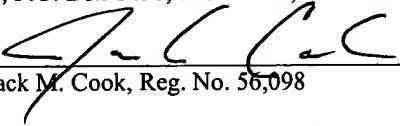
Thilmany 119236.00013

Doc. No. 5844406



I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Date of Signature and Deposit: 1/25/06


Jack M. Cook, Reg. No. 56,098

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gary H. Knauf
Application.: 09/978,524
Filed: October 16, 2001
For: METHOD FOR EXTRUSION COATING A LIGHTWEIGHT WEB
Group Art Unit: 1762
Examiner: Tsoy, Elena
Attorney's Docket: 119236.00013

REASONS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

The primary point of contention in the present application can be simplified to the following question: Is there a difference between an extruded film that covers a surface of a web and a preformed film that is designed as a laminate to be positioned over a web? Applicant asserts that an extruded film is very different from a preformed film and that one of ordinary skill in the art would readily appreciate that they are not "functionally equivalent", as maintained in the Office Actions of record.

In particular, in an attempt to combine Backwell and Marrocco, III et al., the Office Actions of record have asserted that laminating preformed films is *functionally equivalent* to the extrusion of "a polymer film coating onto the lightweight web and carrier web," as called for in claim 1. However, this conclusion is unsupported by the art of record and is contrary to the understanding of one of skill in the art.

First, one of ordinary skill in the art would recognize that the art of record teaches a preformed film laminate, which in the art is biaxially stretched to yield substantial strength against tearing along both the length and width of the film laminate. On the other hand, one of

ordinary skill in the art would readily recognize that since the claimed film is "extruded" it is stretched linearly along its length and, thus, only yields substantial resistance tearing in one direction.

Second, one of ordinary skill in the art would readily recognize that the preformed film laminates taught in the art of record require an adhesive in order to be affixed to the web upon which it is positioned to protect. However, by extruding the claimed polymer film coating onto the lightweight web and carrier web, no adhesive is necessary.

For at least these reasons, laminating preformed films cannot be said to be "functionally equivalent" to the extrusion of "a polymer film coating onto the lightweight web and carrier web," as called for in claim 1. Accordingly, Applicant respectfully asserts that the rejection proffered in the Office Actions of record cannot be sustained. Therefore, Applicant requests that the Review Panel find that the present application should be allowed and prosecution on the merits closed.

The Commissioner is hereby authorized to deduct any additional fees arising as a result of this or any other communication regarding this application from Deposit Account No. 17-0055.

Respectfully submitted,

GARY H. KNAUF



Jack M. Cook
Reg. No. 56,098
Attorney for Applicants
Quarles & Brady LLP
411 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-4497
Tel. No. (414) 277-5405